

REMARKS

In this paper, claims 10, 12-14, 17, 18, 22-24, 28, 29, 31-46, 48 and 50-53 are currently amended. After entry of the above amendment, claims 10, 12-14, 16-19, 22-24 26-48 and 50-53 are pending, and claims 1-9, 11, 15, 20-21, 25 and 49 have been canceled.

Claims 10, 12-14, 18, 22-24, 29, 44-46 and 50 were rejected under 35 U.S.C. §112 as being indefinite.

As for the recitation of “axle opening dimensioned to receive a rear wheel axle of a bicycle therein,” there is nothing wrong with defining the dimensions of a device in terms of the environment in which it is to be used. See *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575-76, 1 USPQ2d 1081, 1087-88 (Fed. Cir. 1986) (holding that the limitation that the claimed wheelchair have a “front leg portion ... so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof” was not indefinite). Furthermore, a walk through any bicycle store will show that axle sizes do *not* vary much, if at all.

As for the recitation of “when the bracket is mounted to the bicycle and the bicycle is vertically upright” in claims 10 and 12, those claims are directed to the bell crank mounting bracket alone. The reference to the bicycle helps a competitor determine the scope of the claims and avoid infringement.

Claims 12 and 44 have been amended to overcome the remaining objections noted at page 3 of the office action.

Claims 10, 14, 18 and 51-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Swensen (US 3,184,993). This basis for rejection is respectfully traversed.

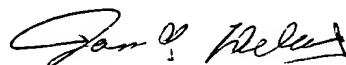
The office action states that it would be obvious to modify the dimensions of opening (6a) in the Swensen device to receive an axle therein. However, “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski*, 10 USPQ2d 1397 (Fed.Cir. 1989). The *Rose* case

cited in the office action is inapplicable to the present claims. Unlike the *Rose* case, the present case is not attempting to base patentability on the overall size of an article. The size limitation is applied to a particular feature (opening) of the bracket. As such, there must be a reason why one of ordinary skill in the art would be motivated to enlarge opening (6a) in the Swensen derailleur to receive an axle therethrough, given that opening (6a) is an opening used to attach the derailleur guard to a pin (a2) of derailleur (a) and the derailleur guard already has an axle opening (6a). Furthermore, the motivation to combine must be clear and particular, and it must be supported by actual evidence.

Teleflex, Inc. v. Ficosa North America Corp., 63 USPQ.2d 1374, 1387 (Fed.Cir. 2002). For the above reasons, the applicant submits that there is no evidence of a motivation to enlarge Swensen's opening (6a) to receive an axle therethrough.

Accordingly, it is believed that the rejections under 35 U.S.C. §103 and §112 have been overcome by the foregoing amendment and remarks, and it is submitted that the claims are in condition for allowance. Reconsideration of this application as amended is respectfully requested. Allowance of all claims is earnestly solicited.

Respectfully submitted,



James A. Deland  
Reg. No. 31,242

DELAND LAW OFFICE  
P.O. Box 69  
Klamath River, California 96050  
(530) 465-2430